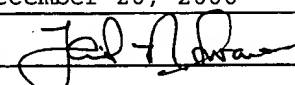




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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		15-EC-5773 (GEMS:0122)	
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		09/747,041	12/22/2000
		First Named Inventor	
		Raymond J. Kelley	
		Art Unit	Examiner
		3628	Oyebisi, Ojo O.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. <u>48,226</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE


In re Application of:
Raymond J. Kelley et al.

Serial No.: 09/747,041
Filed: December 22, 2000

For: Web-based Medical Diagnostic
System Financial Operation Planning
System and Method

§
§ Group Art Unit: 3628
§
§ Examiner: Oyebisi, Ojo O.
§
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§ Atty. Docket: GEMS:0122/SWA
§ 15-EC-5773
§

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December 20, 2006 Date	 Taif R. Swanson

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action mailed on September 20, 2006, and the Advisory Action mailed December 18, 2006, Appellants respectfully submit this Pre-Appeal Brief Request for Review. This Request is being filed concurrently with a Notice of Appeal.

In the Final Office Action mailed on September 20, 2006, the Examiner rejected claims 1-3, 5-25, 27-50, 52-54, and 56-58 under 35 U.S.C. § 103 as obvious over Eder (US Patent 6,321,205, hereinafter "Eder"). In the Advisory Action mailed on December 18, 2006, the Examiner relied on the Final Office Action without making any further arguments. The Appellants, however, respectfully submit that these rejections are clearly improper in view of several clear legal and factual deficiencies in the Examiner's rejections.

Response to Arguments

The Final Office included a "Response to Arguments" section beginning on page 17 and ending on page 21. In this section, the Examiner focused on the data rather than its function and interrelationship with the resulting report to enable a client to evaluate a prospective purchase option. For example, the Examiner stated:

These information are nothing but a compilation of data, which coincides with the definition of non-functional descriptive material in MPEP 2106. Final Office Action, page 18 (emphasis added).

First, the Appellants note that Section 2106 of the Manual of Patent Examining Procedure relates generally to 35 U.S.C. § 101 rather than § 103. For this reason, the Appellants respectfully submit that the Examiner's rejection is a clear legal error and cannot stand. Even in Section 2106 (VI), the Manual of Patent Examining Procedure states:

Reviewing a claimed invention for compliance with 35 U.S.C. 102 and 103 begins with a comparison of the claimed subject matter to what is known in the prior art. ... Once differences are identified between the claimed invention and the prior art, those differences must be assessed and resolved in light of the knowledge possessed by a person of ordinary skill in the art. Against this backdrop, one must determine whether the invention would have been obvious at the time the invention was made. If not, the claimed invention satisfies 35 U.S.C. 103.

M.P.E.P. (Rev. 5, August 2006) § 2106, pages 2100-14 and 2100-15 (emphasis added).

The Appellants respectfully stress that Section 2143.03 of the Manual of Patent Examining Procedure states:

All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

M.P.E.P. (Rev. 5, August 2006) § 2143.03, page 2100-131 (emphasis added). Clearly, the Examiner disregarded certain features of the claims, rather than considering all words of the claims. In view of the passage above, the Examiner’s rejections are based on one or more clear legal and factual errors and cannot stand.

Second, the Appellants stress that the claims clearly correlate the data to a specific function, which is missing from the Eder reference. For example, the claims generally relate to a prospective purchase of medical equipment, and a report to enable a client to evaluate the feasibility of such a purchase. Specifically, independent claim 1 recites, *inter alia*, “analyzing a prospective purchasing option selected from a plurality of different purchasing options to obtain the prospective medical imaging system based on the financial data of the client to provide a client-specific financial analysis of the prospective purchasing option.” Specifically, independent claim 19 recites, *inter alia*, “the financial analysis system is configured to evaluate the client data and to generate a projected financial report for the prospective medical imaging system tailored to the client data, wherein the projected financial report enables a client to evaluate feasibility of purchasing the prospective medical imaging system.” Specifically, independent claim 34 recites, *inter alia*, “returning a pro forma financial report to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the prospective medical imaging system for incorporation into operations of the client at the healthcare facility.” Specifically, independent claim 43 recites, *inter alia*, “an Internet results page for displaying a projected financial statistic from the financial analysis system, wherein the projected financial statistic indicates a financial outlook of the potential purchase transaction to assist an individual with the potential purchase transaction.”

In sharp contrast, the Eder reference merely discloses general business evaluation, rather than anything related to a specific purchase transaction. Even outside the context of medical equipment, the Eder reference clearly fails to teach or suggest analysis of a prospective purchase transaction in which operational data of the equipment is analyzed in the process. Although the Appellants do not intend or suggest that the specification should be read into the claims, the Appellants submit that the specification provides context and meaning to the claims. For example, the specification discloses that “medical institutions must evaluate the feasibility of investing in new, additional or upgraded medical resources to better serve patients and become more efficient

and profitable” and that the “seller may simply ignore the financial position of the prospective purchaser, and offer a standard transaction option not suitable or feasible for that purchaser,” and finally that “there is a need for a technique for analyzing a desired medical resource investment for a medical institution based on financial data from the medical institution, and for providing a plurality of transaction options tailored to the financial data.” Application, page 1, lines 18-27; page 3, lines 8-12 and 25-30; page 4, line 1. In view of these passages, the Appellants stress that the present claims recite prospective purchasing options that are client-specific or tailored to the client based on the client’s data, e.g., operational data associated with the relevant equipment. The Eder reference simply fails to teach or suggest such a system and method.

Third, the Examiner asserted that certain claim features are merely an intended use, and that the Eder reference teaches a system capable of performing such an intended use. See Final Office Action, page 17. However, the Appellants stress that the present claims recite much more than a mere intended use of the Eder system in the field of medicine. Again, the Eder reference does not teach or suggest a prospective purchase analysis for a specific piece of equipment, much less a piece of medical equipment. For example, not only is the Eder reference missing a “device purchase-analysis form,” but the Eder reference is missing a “medical-imaging-device purchase-analysis form” as recited in claim 1. The claim does not merely recite a generic form for use with medical data, but the form itself is specifically claimed as a “medical-imaging-device purchase-analysis form.” Although Eder may include some sort of forms that could hypothetically be used with medical data, the Eder reference clearly fails to disclose the specific type of form recited in the present claims, e.g., “medical-imaging-device purchase-analysis form.” Moreover, the Eder reference fails to disclose use of forms for purchase analysis of specific equipment. For at least these reasons, among others, the Appellants stress that the Examiner’s rejection is based on one or more clear legal and factual errors and cannot stand.

Features of Independent Claim 1 Missing From Eder

Claim 1 recites “providing an electronic form comprising a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system”. Further, the form is “configured to enable entry of financial data including system operational data for the prospective medical imaging system.”

In contrast, the Eder reference fails to teach or suggest an “electronic form comprising a medical-imaging-device purchase-analysis form configured to enable selection of fields for selecting a prospective medical imaging system.” Nor does Eder teach system operational data for the medical imaging system. Eder discloses *general non-medical* user inputs which define data fields used by software. See col. 18, lines 12-20. The software taught by the Eder reference is directed towards extracting, aggregating and storing transaction data associated with *intangible* assets. See, Eder, col. 8, lines 1-10; col. 5, lines 12-15. Hence, the forms taught by Eder are incapable of accommodating system operational data of a medical imaging system. For example, system operational data include a variety of operational data determined by the medical imaging system’s specification, such as operational and maintenance cost, patient throughput, availability, etc. These parameters are specific to a medical imaging system and cannot be covered by the forms provided by Eder. Further, in rejecting the claims, the Examiner pointed out instances in which Eder discloses system operational data. See Final Office Action, page 4. Appellants contend that no such disclosure

appears to be found in the Eder reference. Therefore, Appellants request the Panel to further clarify where such disclosure exists in the Eder reference. Absent any such disclosure, the rejection of claim 1 cannot stand.

Further, claim 1 recites “analyzing a prospective purchasing option...to obtain the prospective medical imaging system”, based on the financial data of the client “to provide a client-specific financial analysis of the prospective purchasing option.” In contrast, the Eder reference discloses generic purchasing subsystems, wherein “[t]hese systems incorporate worksheets, files, tables and databases...[that] contain information about the company operations and its related accounting transactions.” See, e.g., Eder, col. 12, lines 57-60; see also table 6. Thus, the systems disclosed by the Eder reference are not specifically tailored for analyzing a prospective purchase of a system, much less a medical imaging system.

Features of Independent Claim 19 Missing From the Cited Combination

Claim 19 recites an interface, “wherein the interface includes a medical-diagnostic-device purchase-analysis-form having fields configured to enable selection of a prospective medical imaging system”. Claim 19 further recites a system configured to generate a projected financial report tailored to client data “wherein the projected financial report enables a client to evaluate feasibility of purchasing the prospective medical imaging systems.”

In stark contrast, Eder is absolutely devoid of an interface which includes a medical-diagnostic-device purchase-analysis-form having fields configured to enable selection of a prospective medical imaging system. Similarly, Eder is devoid of a financial report tailored to such systems. See, generally, Eder, col. 12, lines 32-67; Figures 1-9C. The cited reference clearly fails to disclose techniques for evaluating client data associated with a medical imaging system. The system disclosed by Eder is incompatible with specific financial data (e.g., variable and fixed costs, revenues, deductions, etc.) of medical imaging systems. The types of interfaces and financial reports recited in claim 19 are clearly structured or configured for evaluating client data of a medical imaging system, and are not a simple representation of applying the generic business accounting techniques disclosed in Eder to a medical imaging system. Rather, the claimed interface and financial report denotes types of interfaces and financial reports that are different than any interface or report described in the Eder reference.

Further, in rejecting the claim the Examiner pointed out that the Eder reference discloses the claimed “wherein the projected financial report enables a client to evaluate feasibility of purchasing the desired system.” Final Office Action, page 6. However, the Examiner does not appear to indicate where such disclosure is found in the Eder reference. The Appellants request the Panel to specifically indicate where the claimed subject matter is indicated in the Eder reference. Absent any such disclosure, the rejection of claims 19 is improper and should be withdrawn.

Features of Independent Claim 34 Missing From the Cited Combination

Claim 34 recites “providing an interface having a form comprising a medical-imaging-device purchase-analysis form configured to enable selection of prospective medical imaging system” and a form for “entering client data relating to the healthcare facility including system operational data of the prospective medical imaging system.” Conversely, the Eder reference does not teach or suggest

a *form* for entering of client data related to a healthcare facility and/or a medical imaging system. Instead, as discussed above, Eder provides for forms to extract, aggregate and store transaction data associated with *intangible* assets (not system operational data). Eder, col. 8, lines 1-10; col. 5, lines 12-15. Independent claim 34 further recites “returning a *pro forma financial report* to a client via the network to enable the client to evaluate feasibility of a possible transaction to obtain the prospective medical imaging system.” The Eder system displays financial forecasts projecting a firm’s growth based on option pricing and cash flow analysis. Eder col. 6, lines 25-64. Eder simply does not disclose returning a *pro forma financial report*, much less a *pro forma financial report* to enable a client to evaluate feasibility of a transaction to obtain a medical imaging system.

Features of Independent Claim 43 Missing From the Cited Combination

Claim 43 recites “an Internet query form having a medical-diagnostic-device purchase-analysis-form having a plurality of data entry fields configured for accepting financial data of a prospective medical diagnostic system”, wherein the entry fields include “a medical *operational time field associated with efficiency of the prospective medical diagnostic system for a potential purchase transaction*.” Claim 43 further recites “a revenue field associated with the medical diagnostic system.” In contrast, Eder does not teach or suggest an internet query *form* having data entry *fields* accepting financial data of a medical diagnostic system. Furthermore, Eder clearly does not disclose a *system* for financially analyzing a potential purchase transaction of a prospective medical diagnostic system. Thus, Eder can not teach the related *Internet results page*. Again, Eder instead provides a financial forecast based on option pricing and cash flow analysis. Eder col. 6, lines 25-64.

Features of dependent Claim 53 Missing From the Eder

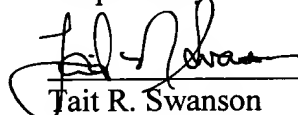
Claim 53 is directly dependent from claim 1. The claim recites “medical resource options include a magnetic resonance imaging (MRI) system, a computed tomography (CT) system, an ultrasound system, or any combination thereof.” Again, Appellants respectfully submit the modalities recited in the above claim are not disclosed or suggested by the Eder and Javit references. More critically, the forms provided by these references are not suitable for providing fields to accept financial data including system operational data of imaging systems, such as MRI, CT, ultrasound or any combination thereof.

Request Withdrawal of Rejection

For these reasons, among others, the Appellants respectfully request withdrawal of the rejections under 35 U.S.C. § 103.

Date: December 20, 2006

Respectfully submitted,



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